

**REMARKS/ARGUMENTS**

No further amendments have been introduced. Thus, the status of claims are:

Claims 1-2, 5-13, 16, 17, 23-25 and 34 currently pending.

Claims 3-4, 14-25, 18-22 have been cancelled.

Claim 34 is allowed.

Claims 12, 13, 16 and 17 stand rejected as broadened outside the two year statutory period.

However, such is authorized by MPEP 1412.03

In addition, a broadened claim can be presented *after* two years from the grant of the original patent in a broadening reissue application which was filed *within* two years from the grant. Where any intent to broaden is unequivocally indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period. (Note: A statement that "the patent is wholly or partly inoperative by reason of claiming more or less than applicant had a right to claim" is NOT an unequivocal statement of an intent to broaden.)< Thus, a broadened claim may be presented in a reissue application after the two years, even though the broadened claim presented after the two years is different than the broadened claim presented within the two years.

It is recognized that *Ex parte Staats*, BPAI (2010) (appeal to Federal Circuit pending) seeks to limit the permissive language of MPEP 1412.03 in a situation when a broadening reissue was filed directed to a particular embodiment and eight years later in a granddaughter continuation reissue broadening claims to an entirely unrelated embodiment were first presented. Thus, the Board considered the amendment to have been unforeseeable and unreasonably delayed.

The present facts and circumstances are distinct from *Ex parte Staats* in that the broadening at issue is related to the embodiment claimed in the broadened claim (claim 34) in the original reissue filing. Claim 34 is directed to DNA transgene sequences suitable for producing fibrinogen. The DNA sequences can be used in accordance with the method of claim

12. Claim 34 specifies that the coding segments are operably linked to additional DNA segments required for expression but does not limit these segments to a beta-lactoglobulin promoter. Given that new claim 34 directed to DNA segments does not restrict the beta-lactoglobulin promoter, it is foreseeable that claim 12, which is directed to a method of use of such DNA segments, would be amended to be commensurate in scope as to the regulatory sequences employed in claim 34. Furthermore, in contrast to the situation in *Ex parte Staats*, the amendment of claim 12, which effectively defines the regulatory sequences in a manner consistent with claim 34, was not made in a granddaughter case, but in the same reissue as the original broadening claim was made.

The present situation is more analogous to that in *In re Doll*, 164 USPQ 218, 220 (CCPA 1970), in which a broadening reissue was filed within two years, but additional claims broader than those present in the original reissue filing were added subsequently. The new claims lacked an element present in the originally filed broadened reissue claims, but were nevertheless considered to be generally directed to the same invention and were thus found permissible.

Such is also the case here. The present situation is not one in which applicant has switched from one broadened invention to another entirely distinct broadened invention many years after filing a broadened reissue, but rather one in which applicants has amended a method of use claim for similarity of scope with a broadened composition claim added by the reissue. Both claims are nevertheless generally directed to the same type of invention (i.e., transgene for fibrinogen expression or method of use of such a transgene for fibrinogen expression). Thus, the broadening of claim 12 presented in the reissue application after two years is submitted to be consistent with the MPEP 1412.03 and 35 USC 251 "a broadened claim may be presented in a reissue application after the two years, even though the broadened claim presented after the two years is different than the broadened claim presented within the two years."

Claims 12, 13, 16 and 17 also stand rejected for alleged new matter regarding the term "egg." The Examiner says the specification only contemplates use of fertilized eggs. Claim 12 does not refer to an egg and it is believed the Examiner intended to apply the rejection to claims 1 and 23. However, a passage of the specification referring to the single vector embodiment of the instant claims provides that "Ideally, the three expression units should be on the same DNA

molecule for introduction into eggs” (col. 6, lines 65-66). Furthermore, the specification at col. 3, lines 55-58 indicates that “the term ‘egg’ is used to denote an unfertilized ovum, a fertilized ovum or an early stage embryo.” Read together, these sentences convey that the vectors of the instant claims can be introduced into fertilized or unfertilized eggs. Thus, reconsideration is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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